



14 JUL 2006

Michele M. Simkin  
Foley & Lardner, LLP  
3000 K Street, Suite 500  
Washington, DC 20007

In re Application of	:	
JIANG, et al.	:	
Application No.: 10/534,579	:	
PCT No.: PCT/US03/35946	:	DECISION ON PETITION
Int. Filing Date: 10 November 2003	:	
Priority Date: 13 November 2002	:	UNDER 37 CFR 1.47(a)
Atty. Docket No.: 039386-2266	:	
For: LIPID-ASSOCIATED MOLECULES	:	

This decision is in response to the applicant's "PETITION UNDER 37 C.F.R. § 1.47(a)" filed 27 April 2006 in the United States Patent and Trademark Office (USPTO). As authorized the \$200.00 petition fee will be deducted from deposit account 19-0741.

### **BACKGROUND**

On 10 November 2003, applicant filed international application PCT/US03/35946 which claimed priority to an earlier U.S. application filed 13 November 2002. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States was set to expire at midnight on 13 May 2005.

On 11 May 2005, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a First preliminary amendment and an Application Data Sheet.

On 27 February 2006, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. Applicant was afforded two months to file the required response and advised that this period could be extended pursuant to 37 CFR 1.136(a).

On 27 April 2006, applicant filed the present petition under 37 CFR 1.47(a) to accept the filed declaration without the signature of joint inventors Xin Jiang, Hsin-Ru Chang and Kimberly J. Gietzen.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(i), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. With the filing of the present petition and accompanying papers, applicant has satisfied items 1 and 3.

Regarding inventor Hsin-Ru Chang, applicant has also satisfied item 2 in that applicant has provided a first-hand account (declaration of Ms. Christine Arthur) of the nonsigning inventor's confirmation of delivery of a complete set of the application papers and an express refusal to execute the declaration. Therefore, it is proper to grant the petition as to Hsin-Ru Chang.

As to item (2) and inventors Jiang and Gietzen, Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part: Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47... The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as Internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should include a statement of facts. It is important that the statement contain facts as opposed to conclusions.

While applicant has included Federal Express tracking information for packages mailed to inventors Jiang and Gietzen, these sheets do not contain any receipt signature information. Thus, it is not possible to take the inventors' subsequent silence as a refusal to cooperate. Applicant states that directory assistance did not have a listing for these inventors at their last known addresses. However, it does not appear that any additional searching was performed to locate current contact information as listed above.

Regarding item (4), the filed declaration executed by inventor Murage is defective and is insufficient to satisfy the oath or declarations requirement of 35 CFR 371(c)(4) for entry into the

national stage in the United States of America. Specifically, the declaration submitted includes an alteration that has not been initialed and dated by inventor Murage. (See MPEP §605.04(a) and 37 CFR 1.52(c)). The published international application and filed application data sheet list the inventor's first name as "Jagi" while the declaration executed by the inventor has been altered and the first name spelled as "Jaji."

For the reasons stated above, it is not possible to grant applicant's petition at this time.

### **CONCLUSION**

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED without prejudice**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3294  
Fax: (571) 273-0459